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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/605,780	10/26/2003	Chia-Jen Wang	DATP0001USA	2779

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NORTH AMERICA INTERNATIONAL PATENT OFFICE (NAIPC)
P.O. BOX 506
MERRIFIELD, VA 22116

EXAMINER

DATSKOVSKIY, MICHAEL V

ART UNIT	PAPER NUMBER
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2835

DATE MAILED: 04/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/605,780

Applicant(s)

WANG, CHIA-JEN

Examiner

Michael V. Datskovskiy

Art Unit

2835

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. §.133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) 1,3-5,7-10,12,14-18,20 and 21 is/are rejected.
- 7) ☐ Claim(s) 2,6,11,13 and 19 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

2. Claims 1 and 3-11 as dependent on the claim 1 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The functional recitation that: the cover and the chamber can be "bare-handedly disassembled" has not been given patentable weight because it is narrative in form. In order to be given patentable weight, a functional recitation must be expressed as a "means" for performing the specified function, as set forth in 35 U.S.C. § 112, 6th paragraph, and must be supported by recitation in the claim of sufficient structure to warrant the presence of the functional language. In re Fuller, 1929 C.D. 172; 388 O.G. 279. (In this case claims 2 and 13 do it to solves a problem). It would be also much better to change the term: "bare-handedly disassemble screws" in claims 2 and 13 to the term: "Thumb screws" which is an art recognizable commonly used term to define such screws. That said it is important to point out that structural limitations related to the presence of these "Thumb screws" from examiner's point of view are the only structural limitations for independent claim 1 and dependent claims 2 and 13, which would make them patentable. All other content of that claims generally discloses a well known in the art design of an external disk drive, which would be obvious to equip with couples of also well known in the art mesh covered air vents.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 3-5, 7, 9-10, 12, 14-18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sarraf (US Patent 4,926,291) in view of Mitchell et al (US Patent 6,211,458) or Heard (US Patent Application Publication 2002/0080580A1). Sarraf discloses an external hard disk assembly, Figs. 1-4, comprising: a hard disk 22; a housing having a base 10 and a cover 30; a circuit board 90 next to the hard disk and comprising all signal and power interconnections between said housing and hard disk and between said housing and a computer. Sarraf does not teach said housing having a plurality of meshes to allow air to pass in and out of a chamber inside said housing, instead teaching a plurality of air vents. Mitchell et al and Heard each teaches an electronic device comprising an air vent covered with a metal mesh. It would have been obvious to one ordinary skilled in the art at the time invention was made to employ a metal mesh areas as of air vents in the device by Sarraf as it is disclosed by Mitchell et al or Heard, in order to provide adequate EMI protection of an interior circuitry of the device. Regarding to the claims 4 and 17: Although Sarraf teaches an external hard disk device comprising a SCSI port, as a most advanced at the time, it would have been an obvious matter of design choice to employ a USB or IEEE 1394 or ATA connection port, since applicant has not disclosed that a type of a signal connection solves any stated

problem or is for any particular purpose and it appears that the invention would perform equally well with any kind of signal connection.

5. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kammergard et al in view of Mitchell et al or Heard.

Kammergard et al teach all the limitations of the claims including that said hard disk is overlapping a control circuit board. Mitchell et al and Heard each teaches an electronic device comprising an air vent covered with a metal mesh. It would have been obvious to one ordinary skilled in the art at the time invention was made to employ a metal mesh areas as of air vents in the device by Kammergard et al as it is disclosed by Mitchell et al or Heard, in order to provide adequate EMI protection of an interior circuitry of the device.

Allowable Subject Matter

6. Claims 2, 6, 11, 13, 19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. The following is a statement of reasons for the indication of allowable subject matter: Bare-handedly disassemble screws (Thumb screws) to fasten the cover (claims 2, 13); A read-write state indicator placed in the chamber (claims 6, 19); A support for fixing the housing (claim 6). Also although thumbscrews are well known in the art, examiner has not found any reason to include thumbscrews for fixing a cover in the devices by Sarraf or Kammergard et al.


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8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Shi-Tsung (US Patent Application Publication 2004/0174676A1); Shah et al (US Patent Application Publication 2005/0013110A1); Anderson et al (US Patent 5,604,662); Sample et al (US Patent Application Publication 2005/0001988A1); Lum (US Patent Application Publication 2005/0060444A1); Jitsukawa (US Patent 6,822,843); Orr (US Patent 5,909,357); German Patent DE 29604784 and Watanabe et al (Japan Patent JP02001267775A).

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael V. Datskovskiy whose telephone number is (571) 272-2040. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynn Feild can be reached on (571) 272-2092. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


04/06/05

Michael V Datskovskiy
Primary Examiner
Art Unit 2835